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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/642,891	08/18/2003	Fritz Tollner	85883.8276	3353
22242	7590	09/13/2006		
FITCH EVEN TABIN AND FLANNERY 120 SOUTH LA SALLE STREET SUITE 1600 CHICAGO, IL 60603-3406			EXAMINER MARCANTONI, PAUL D	
			ART UNIT 1755	PAPER NUMBER

DATE MAILED: 09/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/642,891	Applicant(s) TOLLNER, FRITZ	
	Examiner Paul Marcantoni	Art Unit 1755	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 June 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 1, 10, 13-15 and 20-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-9, 11, 12, and 16-19 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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The applicants' amendment and response of 6/30/06 has been considered but has been determined to not be persuasive.

Claim 10:

Applicants indicate claim 10 as withdrawn yet it is not a withdrawn but an active and pending claim. It has been treated thus as an active and pending claim.

New Claims Non-Elected By Original Presentation:

Newly submitted claims 20-22 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 20-23 that are newly added are directed to a concrete article which is an election non-elected so these claims have been withdrawn. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 20-23 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

35 USC 112-Second Paragraph:

Claims 2-9, 11, 12, and 16-19 are rejected under the second paragraph of 35 USC for failing to particularly point out and distinctly claiming the instant invention. Claim 11 and its dependent claims, as a result of claims 3 and 5, are indefinite. There is no distinction between "polyacrylates" (thickener) which is inclusive of polyacrylate

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resin (hydrophobing additive), "polyurethanes" (thickener) and polyurethane resin (hydrophobing additive), and "silicic acid derivatives" (thickener) and silicic acid esters (hydrophobing additive). Note that polyacrylate resin is inclusive of the genus polyacrylates and polyurethane resin is inclusive of the genus polyurethanes. Further, silicic acid esters are an example of silicic acid derivatives and there is thus no distinction between "thickener" and "hydrophobing agent".

Claim 11 is also indefinite because it is unclear how an article can be made in claim 11 as there is no step of molding. It is evident applicant are creating a cement mixture but there is no step of molding, setting, and curing which would be requisite of forming a cement/concrete article.

Such as improper claim language:

Applicants should delete the terms "such as concrete additives or concrete addition agents" in claim 7 and insert in its place ---selected from the group consisting of one or more concrete additives--- Note that the terms concrete additives and concrete addition agents are redundant and this would resolve this by this suggested amendment.

35 USC 103:

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2-9, 11, 12, and 16-19 are rejected under 35 USC 103 over Butler et al. (US 5,766,323) as rendering obvious the applicants' claimed invention.

Butler et al. (hereafter Butler) teaches a method of making a cementitious material. It would have been obvious to one of ordinary skill in the art that a cementitious article is made from a cementitious material. Butler teaches that he mixes cement, water, polyacrylate beads (thickener-see claim 14 in col.10), polyoxyethylene wax (claim 13 in col.10-has hydrophobing properties because it's a "wax" as that is all that is required in applicants' claims), and organopolysiloxane (also a hydrophobing additive). The applicants' further addition of surfactants, air pore formers (ie air entraining agents), retarders, accelerators, colorants such as dyes and pigments etc. are merely conventional additive known for addition to cement or concrete compositions (see col.3, lines 35-43).

Further, the applicants addition of a thickener as part of one component with thickener and hydrophobing additive as not unobvious over the prior art either. Applicants merely add these two ingredients together or simultaneously as one component when it would have been an obvious design choice to add the ingredients simultaneously or individually one at a time. *Changes in the sequence of adding ingredients would have been an obvious design choice to one of ordinary skill in the art absent evidence to the contrary.* (See MPEP 2144.04-Legal Precedent as Source of Supporting Rationale which lists the case law *In re Gibson* 5 USPQ CCPA 1930 under Change in Sequence of Adding Ingredients).

Response:

The applicants requested the examiner provide teaching that the addition of surfactants, colorants, retarders, accelerators, air pore formers (ie air entrainers) is conventional. In rebuttal, this teaching is provided within the Butler reference itself (see col.3, lines 35-43). These are conventional additives as shown by Butler and he teaches them so they meet the limitations of applicants' claims.

The applicants argue that their order of adding ingredients is not simultaneous which they state occurs in Butler (col.4, lines 12-56) and ~~that they do~~ ^{examiner does} not provide any teaching that changing the order of adding ingredients would have been prima facie obvious to one of ordinary skill in the art. In rebuttal, and as was discussed in the November 22, 2005 telephonic interview with applicants' counsel, Mr. John Gresens, the examiner maintained the position that is consistent with In re Gibson and can also be found in MPEP 2144.04 that the change in the sequence of adding ingredients would have been prima facie obvious to one of ordinary skill in the art absent evidence to the contrary. The examiner maintains his position that this is proper as shown by the decided case law that was listed in Chapter 2100 of the MPEP. This sufficiently teaches that changing the order of adding ingredients is obvious to one of ordinary skill in the art.

Applicants also argue that only by employing the separate steps of mixing, the optimum effect of the concrete thickener is achieved (p.7 second paragraph of applicants' specification). They note that the conventionally done direct addition of

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thickener onto the stone grains is not possible here. In rebuttal, the applicants infer that Butler teaches adding thickener directly onto the stone grains yet this reference does not teach this allegedly conventional treatment. That same paragraph would appear to support the examiner's position because the optimum effect of the concrete thickener is *preferably* (not must be which is a big difference) achieved by adding thickener to the otherwised finished mixture of the concrete additive. The specification by applicants' use of *preferably* means the optimum thickener effect can thus also be achieved by a different order and not necessarily adding thickener to the finished concrete mixture. This thus does not support that the applicants order of adding ingredients is critical but stating by applicants' using the term preferably in their specification seems to indicate In re Gibson applies. This is because the order sequence of adding ingredients is not critical and thus would have been an obvious design choice to one of ordinary skill in the art.

It is also noted that the rejection was proper under 35 USC 103 as well because overlapping ranges of amounts of the prior art render applicants' process claims prima facie obvious to one of ordinary skill in the art

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paul Marcantoni whose telephone number is 571-272-1373. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Paul Marcantoni
Primary Examiner
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